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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,196

01/14/2004

Mohinder Singh

CU-3535 BSE

3585

26530 7590 02/12/2007
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EXAMINER

CRAIG, PAULA L

ART UNIT

PAPER NUMBER

3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/757,196

Applicant(s)

SINGH, MOHINDER

Examiner

Paula L. Craig

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,10 and 12-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,10 and 12-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 20, 2006 have been fully considered but they are not persuasive. Applicant argues that neither Kageyama (6,227,739) nor Green (5,829,976) teach the viscosity of the anesthetic being such that the anesthetic will not leak from the applicator unless pressure is applied to the anesthetic. The applicator disclosed by Applicant appears to be identical to the applicator of Kageyama in all respects, indeed the disclosure of Kageyama '739 is incorporated by reference in Applicant's specification and indicated as a suitable applicator (see Applicant's specification, page 3, lines 4-6; compare Applicant's figures to the figures of Kageyama). Kageyama discloses an easy-to-manufacture, inexpensive applicator which is suitable for dispensing a variety of liquids, including cosmetic liquids, ink, and correcting liquid (col. 1, lines 4-8, col. 3, lines 42-45). All of these liquids are known to be viscous to at least some extent. The applicator of Kageyama has an open end, with the liquid being dispensed through a narrow tip pipe and through the bristle tip (Kageyama, Figs. 1-5, col. 5, lines 7-58). Kageyama does not include any component holding the liquid inside the reservoir other than the narrowness of the tip pipe and the bristle tip relative to the reservoir. The applicator of Kageyama would be unable to function as described in Kageyama if the liquid leaked from the applicator without the application of pressure to the reservoir. A viscosity sufficient to prevent the liquid from leaking out of the applicator without the application of pressure to the reservoir is

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therefore considered to be inherent in Kageyama. The burden to show that this, in fact, is not the case is shifted to Applicant as per *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

2. Note that the use of benzocaine as an anesthetic and sucralose as a sweetener in oral and dental compositions is well known, as indicated in U.S. Patent Application Publication Nos. 2003/0211051 to Majeti et al., 2003/0124065 to Majeti et al., 2004/0101492 to Dolan et al., and 2004/0131662 to Davidson et al. U.S. Patent No. 6,120,789 to Dunn and U.S. Patent Application Publication No. 2002/0187108 to Rajaiah et al. each teach that an oral care composition including benzocaine can be applied by a variety of means, including squirting from a tube, using a brush, or using a pen-type applicator.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The rejections of Claims 1, 5, 10, and 12-15 under 35 U.S.C. 103(a) over Kageyama (6,227,739) in view of Green (5,829,976) are maintained for the reasons of record, as well as the reasons indicated above in paragraphs 1-2.

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5. Claims 16, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama in view of Green, and further in view of U.S. Patent No. 6,423,750 to Johnson.

6. For Claims 16, 23 and 27, Kageyama/Green teach all the limitations of Claim 1, as described above in paragraph 4. Green teaches the liquid or gel being a topical anesthetic for use in treatment of infected teeth and gums (col. 1, lines 12-15, col. 4, lines 44-51, Claim 11). Kageyama does not teach the anesthetic composition being comprised of benzocaine. However, benzocaine is a well-known anesthetic for use in anesthetic compositions. Johnson confirms this and teaches an anesthetic composition including benzocaine for use in a bristle-tipped applicator to relieve pain during treatment of mouth sores and other painful skin conditions (Abstract, Figs. 1-11, col. 8, lines 26-52, col. 16, lines 33-60). Applicant's specification does not disclose that benzocaine solves any particular problem or has any advantage over other anesthetics. It would have been obvious to one of ordinary skill in the art to modify Kageyama/Green to include benzocaine in the anesthetic composition to relieve pain, as taught by Johnson.

7. Claims 17-19, 24-26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama in view of Green, and further in view of Johnson and U.S. Patent No. 4,435,440 to Hough et al.

8. For Claims 17-19, 24-26, and 28-30, Kageyama/Green/Johnson teach all the limitations of Claims 16, 23, and 27, as described above in paragraph 6. Green teaches

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the liquid or gel being a topical anesthetic for use in the mouth for treatment of infected teeth and gums (col. 1, lines 12-15, col. 4, lines 44-51, Claim 11). Kageyama does not teach the anesthetic composition including a sweetener. However, it is well known in the art to include a sugar-free sweetener such as sucralose in dental compositions.

Hough confirms this and teaches a sugar-free sweetener for sweetening compositions for use in the mouth, including orally administered pharmaceutical compositions (col. 1, lines 4-21, col. 2, lines 32-42). For Claims 18, 19, 25, 26, 29, and 30, Hough teaches the sweetener being sucralose (col. 1, line 65 to col. 42; note that sucralose is the generic name of the chlorinated sucrose derivative compositions described, as indicated in Merck Index entry for sucralose). Hough teaches that sugar-free sweeteners are advantageous in that they combine a high degree of sweetness with a low risk of dental caries (col. 1, lines 22-28). For Claims 17-19, 24-26, and 28-30, Applicant's specification does not disclose that the use of sucralose in the anesthetic composition solves any particular problem or has any advantage over other sugar-free sweeteners. It would have been obvious to one of ordinary skill in the art to modify Kageyama/Green/Johnson to include the anesthetic composition including a sugar-free sweetener such as sucralose, to sweeten the composition without risk of dental caries, as taught by Hough.

9. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama in view of Green, and further in view of Hough.

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10. For Claims 20-22, Kageyama/Green teach all the limitations of Claim 1, as described above in paragraph 4. Green teaches the liquid or gel being a topical anesthetic for use in the mouth for treatment of infected teeth and gums (col. 1, lines 12-15, col. 4, lines 44-51, Claim 11). Kageyama does not teach the anesthetic composition including a sweetener. However, it is well known in the art to include a sugar-free sweetener such as sucralose in dental compositions. Hough confirms this and teaches a sugar-free sweetener for sweetening compositions for use in the mouth, including orally administered pharmaceutical compositions (col. 1, lines 4-21, col. 2, lines 32-42). Hough teaches that sugar-free sweeteners are advantageous in that they combine a high degree of sweetness with a low risk of dental caries (col. 1, lines 22-28). For Claims 21 and 22, Hough teaches the sweetener being sucralose (col. 1, line 65 to col. 42; note that sucralose is the generic name of the compositions described). For Claims 20-22, Applicant's specification does not disclose that the use of sucralose in the anesthetic composition solves any particular problem or has any advantage over other sugar-free sweeteners. It would have been obvious to one of ordinary skill in the art to modify Kageyama/Green to have the anesthetic composition include a sugar-free sweetener such as sucralose, to sweeten the composition without risk of dental caries, as taught by Hough.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula L. Craig whose telephone number is (571) 272-5964. The examiner can normally be reached on 8:30AM-4:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paula L Craig
Examiner
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